

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

APPELLANT:	Dirk Weseloh	CONFIRMATION NO. 4405
SERIAL NO.:	10/807,691	GROUP ART UNIT: 2455
FILED:	March 24, 2004	EXAMINER: Michael Won Young
TITLE:	METHOD FOR REMOTE MAINTENANCE OF TECHNICAL DEVICES	

MAIL STOP APPEAL BRIEF-PATENTS

Commissioner for Patents
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REPLY TO NEW POINTS RAISED IN EXAMINER'S ANSWER

S I R:

At page 12 of the Examiner's Answer dated August 26, 2009, the Examiner argues that the rejection is based on a combination of the references Azieres and Othmer, and that Othmer explicitly teaches deleting data that has been stored when the access is terminated; and regardless of the direction of travel for the message, the functionality remains the same. But as explained hereafter, the direction of travel is directly relevant to the issue of non-obviousness and cannot be ignored.

When combining prior art references to determine whether the subject matter of a claim is obvious, one cannot use only a selected teaching of the reference while ignoring the context in which that teaching is found which directly bears on the issue of non-obviousness. In the instant appeal, by ignoring or excluding the context in Othmer, the Examiner is engaging in an impermissible hindsight analysis. As succinctly observed by the U.S. Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 27 S.Ct. 1727 (2007), "A fact finder should be aware, of course,

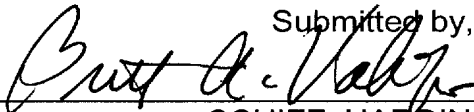
of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning. See *Graham*, 383 U.S. at 36, 86 S.Ct. 684 (warning against 'a temptation to read into the prior art the teachings of the invention in issue' and instructing courts to 'guard against slipping into the use of hindsight')." *KSR* at 1742.

In Othmer the black box data 44 is sent from the computer 34 to the server 32 which is monitoring the computer 34. This black box data is used by the server in the monitoring process. Once the computer 34 has sent the black box data 44 to the server 32, then the black box data is, as taught at column 14, lines 7-18, deleted at the computer 34. But Applicant's claim 15 recites that the automatic deleting of the electronic data in the maintenance computer is dependent on termination of the access *where that access is for remote maintenance by the maintenance computer of the technical device*. In Othmer, the deletion of the black box data 44 at the computer 34 *is not occurring upon termination of access of the monitoring by the server of the computer 34*. Rather, the black box data is being deleted after it has been transmitted to the server 32 and *before* any monitoring, not when the monitor server 32 has completed its monitoring of the computer 34. Contrast this with Applicant's claim 15 where the electronic data being deleted occurs when that maintenance computer has finished its remote maintenance of the technical device. The automatic deleting step at the end of claim 15 follows the step of conducting the remote maintenance. Thus the access referred to in the last paragraph of claim 15 is the termination of the access for this remote maintenance.

Thus there are two separate reasons why the combination of Othmer with Azieres cannot suggest claim 15. First, in Othmer the data being deleted is located

in the technical device being monitored, not at the maintenance computer. This teaches directly away from the concept of claim 15 where it is desired to delete the information in the maintenance computer. Therefore a combination with Azieres is non-obvious. Secondly, the black box information at the computer 34 in Othmer is deleted, not when the monitor server 32 has completed its monitoring of computer 34, but rather when the black box data has been transferred to the monitoring server *before* the server has begun its monitoring of the computer 34. This is also a teaching away from the invention of claim 15, and therefore a combination with Azieres is non-obvious for this reason also. And even if Othmer is combined with Azieres, then one would be deleting data in the technical device of Othmer being remotely maintained and not in the maintenance computer of Othmer. Also the deleting of data would occur before the maintenance and not at the termination of maintenance.

Appellant waives oral argument.

Submitted by,


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